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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Cold Steel, Inc.

Serial No. 74/672,475

Marvin E. Jacobs of Koppel & Jacobs for Cold Steel, Inc.

Theresa K. Kaiser, Trademark Examining Attorney, Law Office 104 (Sidney Moskowitz, Managing Attorney).

Before Seeherman, Quinn and Hohein, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Cold Steel, Inc. has appealed from the refusal of the Trademark Examining Attorney to register VAQUERO for sport knives.[1] Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark, if used on the identified goods, so resembles the mark RUGER VAQUERO, registered for firearms, as to be likely to cause confusion or mistake or to deceive.

[1] Application Serial No. 74/672,475, filed May 4, 1995 and asserting a bona fide intention to use the mark in commerce.

Applicant and the Examining Attorney have filed briefs, and applicant filed a reply brief. An oral hearing was not requested.

Before proceeding to the substantive issue before us, there are some procedural points which we must consider. With its appeal brief applicant submitted copies of certain registrations owned by the registrant, and seven pages of a Dun & Bradstreet report, although it had submitted only three pages from this report during the prosecution of the application. The Examining Attorney objected to our consideration of the registrations and to the newly submitted pages of the Dun & Bradstreet report.

The Examining Attorney's objection is well taken. Trademark Rule 2. 142(d) provides that the record in the application should be complete prior to the filing of an appeal. In its reply brief applicant has requested that we take judicial notice of the registrations or, in the alternative, remand the application for further examination. Both of these requests are denied. The Board does not take judicial notice of registrations that reside in the Patent and Trademark Office. **In re Duofold Inc.**, 184 USPQ 638 (TTAB 1974). Nor has applicant shown good cause to support the request for remand; in point of fact, we see no reason why these registrations and the additional pages of the Dun

& Bradstreet report could not have been submitted prior to the filing of the appeal.[2]

We turn now to the substantive issue in this appeal. In any analysis of likelihood of confusion, two key considerations are the similarity of the goods and the similarity of the marks. See **Federated Foods, Inc. v. Fort Howard Paper Co.**, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). With respect to the goods, applicant seeks to register its mark for sport knives, while the goods identified in the registration are firearms. Clearly, these goods are different. However, it is well established that

> it is not necessary that the goods of the parties be similar or competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective goods of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same person under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer.

In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

In this case, both applicant's and the registrant's identified goods may be sold in sporting goods stores. Both applicant and the Examining Attorney recognize that this

[2] We would point out that, even if these materials had been properly made of record, they would not affect our decision herein.

factor alone may not be sufficient to support a finding of likelihood of confusion. See **Canada Dry Corporation v. American Home Products Corporation**, 175 USPQ 557 (CCPA 1972); **In re Precise Imports Corporation**, 193 USPQ 794 (TTAB 1976). However, there are additional factors here which support a finding that the goods are related. In particular, they are complementary in nature, in that both firearms and sport knives maybe used by hunters as part of their sport. As the Board said in **In re Precise Imports Corporation**, supra, at 796:

> ...the relationship between the products here involved [pocket, hunting and sporting knives vis-à-vis rifles and shotguns] extends beyond common purchasers and common trade channels. There is a definite relationship between these goods in that sportsmen engaged in hunting pursuits would more than likely carry both a rifle or shotgun and a hunting or sporting knife and may well purchase both types of products at the same time in preparation for their trips. And, if they were to encounter both of these products under the same or similar marks, it is difficult to perceive how confusion as to the origin of these goods could be avoided.

Applicant asserts that registrant, in almost 50 years of operation, has never manufactured nor sold knives, and that, according to applicant's president, "I would not nor would anyone active in the sporting knife industry expect [registrant] to expand into the knife business." Declaration of Lynn C. Thompson. While those in the industry may not believe that the registrant is selling

knives, the question we must determine is whether the consumers for knives and firearms would expect both types of goods to emanate from the same source. In connection with this, the Examining Attorney has made of record numerous third-party registrations which show that the registrants have registered their marks for both firearms and knives. See, for example, Registration No. 1,473,950 for guns and rifles and sporting knives; Registration No. 1,407,305 for, inter alia, custom rifles, shotguns and hand guns and sportsmen's knives; Registration No. 1,564,199 for, inter alia, hunting knives and firearms. Although third-party registrations are not evidence that the marks shown therein are in commercial use, or that the public is familiar with them, nevertheless third-party registrations which individually cover a number of different items and which are based on use in commerce may have some probative value to the extent that they serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. **In re Albert Trostel & Sons Co.**, 29 USPQ2d 1783 (TTAB 1993).[3]

[3] Some of the third-party registrations submitted by the Examining Attorney are for house marks which cover a wide variety of goods, e.g., Registration No. 732,002 for SEARS for goods ranging from cosmetics to envelopes to musical instruments to safes to cameras. These registrations have little value in demonstrating that consumers would regard all the goods listed therein as being related. Other registrations, also for a wide range of goods, were issued under the provisions of Section 44(e) of the Trademark Act, based on ownership of a foreign registration rather than use in commerce. Such registrations have little persuasive value in showing that the goods may emanate from a single source.

Because applicant's and registrant's identified goods may be sold in the same channels of trade to the same purchasers, and be used together in connection with hunting animals, and because the evidence shows that such goods may emanate from a single source, we find that applicant's goods are sufficiently related to the registrant's that, if the same or a similar mark were used on applicant's sport knives, confusion would be likely.

This brings us to a consideration of the marks. Applicant's mark, VAQUERO, is identical to the second word of the cited mark, RUGER VAQUERO. As applicant points out, RUGER VAQUERO contains the registrant's house mark along with the word VAQUERO, while applicant's mark is for the word VAQUERO alone. However, we do not think that the inclusion of RUGER in the registered mark distinguishes the two marks. RUGER, as applicant acknowledges, is a recognized house mark of the registrant, brief, p. 4. In the context of the mark RUGER VAQUERO, RUGER will be perceived by consumers as the house mark, and VAQUERO as the mark for the product or the product line. These same consumers, viewing VAQUERO per se on sport knives, are likely to believe that these knives are another product in the registrant's VAQUERO product line. The fact that applicant's mark does not contain the term RUGER is not likely to make consumers conclude that the knives emanate from a different source from registrant's firearms; rather, to the extent that they recognize that the "house mark" is

missing, they will simply assume that the registrant has chosen to use only the product line mark on its goods.

Applicant has asserted that purchasers of sport knives and firearms are discriminating purchasers. While they may be knowledgeable about knives and firearms, the marks RUGER VAQUERO and VAQUERO are so similar that purchasers are likely to believe that the products emanate from the same source. As noted previously, the third-party registrations submitted by the Examining Attorney show that sport knives and firearms may emanate from a single source.

In reaching the conclusion that confusion is likely, we have considered all the duPont factors applicable to this case. In particular, we note applicant's argument that VAQUERO, which means "cowboy," is suggestive of both firearms and knives. Applicant has not submitted any evidence that this term is commonly used or registered for goods such as those involved herein.[4] Further, although cowboys may use firearms and knives, we do not think this term is so highly suggestive that the scope of protection accorded to the registrant's mark would not extend to the use of VAQUERO on such closely related goods as sporting knives.

[4] On the other hand, we note that the Examining Attorney, in order to show that the registrant's mark is strong, has referred to the search statement produced by her search of the Office's records to show that there were only eight other applications or registrations in the Office database that contain the word VAQUERO. Although this search statement is placed in the file for internal record keeping purposes to show the search strategy used by the Examining Attorney, the statement was not provided to the applicant and does not form part of the record.

Finally, we note applicant's reliance on **W.W.W. Pharmaceutical Co. Inc. v. The Gillete Co.**, 984 F.2d 567, 25 USPQ2d 1593 (2d Cir. 1993) *aff'g.* 808 F. Supp. 1013, 23 USPQ2d 1609 (SDNY 1990). However, because of the differences in the records between this inter partes case and the present case, as well as the differences in the marks themselves (including the degree of suggestiveness of the common elements), the inter partes case is of little value in our determination herein. As the Board stated in **In re Cosvetic Labaoratories, Inc.**, 202 USPQ 842, 844 (TTAB 1979), such cases "are not controlling in our determination of the issues of likelihood of confusion presented in these proceedings since it is axiomatic that each case must be decided on its own particular facts," and, quoting **Jaquet-Girard, S.A. v. Girard Perregaux & Cie, S.A.**, 165 USPQ 265 (CCPA 1970), "prior decisions on different marks used under different circumstances are of little value in deciding a specific issue of likelihood of confusion."

Decision: The refusal of registration is affirmed.

E. J. Seeherman

T. J. Quinn

G. D. Hohein
Administrative Trademark Judges
Trademark Trial and Appeal Board